

REMARKS

Claims 21 to 26 are added, claims 13, 16 and 17 are canceled without prejudice, and therefore claims 11, 12, 14, 15 and 18 to 26 are currently pending in the present application.

In view of this response, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

With respect to paragraph two (2) of the Office Action, the specification was objected to for informalities. While the objection may not be agreed with, to facilitate matters, a paragraph has been inserted without prejudice beginning at page 1, line 1 of the Substitute Specification, as suggested. Approval and entry are respectfully requested. It is therefore respectfully requested that the objection be withdrawn.

With respect to paragraph four (4) of the Office Action, claims 11 to 15 were rejected under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 5,334,998 (the Murakami reference).

As regards the anticipation rejections of the claims, to reject a claim under 35 U.S.C. § 102, the Office must demonstrate that each and every claim feature is identically described or contained in a single prior art reference. (See *Scripps Clinic & Research Foundation v. Genentech, Inc.*, 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991)). As explained herein, it is respectfully submitted that the Office Action does not meet this standard, for example, as to all of the features of the claims. Still further, not only must each of the claim features be identically described, an anticipatory reference must also enable a person having ordinary skill in the art to practice the claimed subject matter. (See *Akzo, N.V. v. U.S.I.T.C.*, 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986)).

As further regards the anticipation rejections, to the extent that the Office Action may be relying on the inherency doctrine, it is respectfully submitted that to rely on inherency, the Office must provide a “basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic *necessarily* flows from the teachings of the applied art.” (See M.P.E.P. § 2112; emphasis in original; and see *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Int’f. 1990)). Thus, the M.P.E.P. and the case law make clear that simply because a certain result or characteristic may occur in the prior art does not establish the inherency of that result or characteristic.

While the rejections may not be agreed with, to facilitate matters, claim 11 has been rewritten herein without prejudice to include the feature of claim 13, which has been canceled without prejudice. In particular, claim 11, as presented, now provides the feature

in which at least one of a length and a position of the decoupling element is arranged so that a resonant impedance behavior occurs in the FM frequency range at a connection end of the decoupling element.

The Murakami reference refers to a T-shaped separate main FM antenna 4. For FM, the heating field is only a “subsidiary antenna.” In this case, the antenna base point is situated in the middle of the T. In the context of the presently claimed subject matter (according to the feature of claim 13 which has been included in claim 11), only a decoupling element is provided for FM, with the heating field element as an FM antenna (and additionally as an AM antenna). This decoupling element has a resonant impedance characteristic in the FM region at the “connection end” (antenna base point), with regard to its length and position. The Murakami reference does not in any way identically disclose (nor even suggest) this dimensioning as provided for in the context of the presently claimed subject matter.

In contrast, in the Murakami reference, the antenna effect is fundamentally caused by the T-shaped antenna element, and possibly in a subsidiary manner by the heating field. In the Murakami document, the resonance is controlled in the impedance matching circuit 13 (column 3, line 56, through column 4, line 2). Thus, the Murakami reference does not identically disclose (or even suggest) all of the features of claim 11, as presented.

Accordingly, it is respectfully submitted that claim 11, as presented, is allowable. Claims 12, 14 and 15 depend from claim 11 and are therefore allowable for at least the same reasons as claim 11, as presented.

Accordingly, it is respectfully submitted that claims 11, 12, 14 and 15 are allowable.

Withdrawal of the rejections of the claims is therefore respectfully requested.

With respect to paragraph five (5) of the Office Action, claims 11 and 16 to 19 were rejected under 35 U.S.C. § 102(b) as anticipated by U.S. Patent Application Publication No. 2004/0056810 (the Oka reference).

As an initial matter, claims 16 and 17 have been canceled herein without prejudice, thereby rendering moot the present rejection with respect to claims 16 and 17.

The Oka reference has not been applied as to the feature of claim 13, which has been included in claim 11. It is believed and respectfully submitted that the Oka reference does not in any way identically disclose (nor even suggest) the claim feature as to the resonance characteristics for antenna elements 51 and 52 (which are also called independent antenna elements in Oka, and not “decoupling elements”). Thus, the Oka reference does not identically disclose (or even suggest) all of the features of claim 11, as presented.

Accordingly, it is respectfully submitted that claim 11, as presented, is allowable. Claims 18 and 19 depend from claim 11, as presented, and are therefore allowable for at least the same reasons as claim 11, as presented.

Accordingly, it is respectfully submitted that claims 11, 18 and 19 are allowable.

Withdrawal of the rejections of the claims is therefore respectfully requested.

With respect to paragraph seven (7) of the Office Action, claim 20 was rejected under 35 U.S.C. § 103(a) as unpatentable over the Murakami reference, in view of U.S. Patent No. 6,201,506 (the Endo reference).

To reject a claim under 35 U.S.C. § 103(a), the Office bears the initial burden of presenting a *prima facie* case of obviousness. *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish *prima facie* obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

Also, as clearly indicated by the Supreme Court in *KSR*, it is “important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements” in the manner claimed. *See KSR Int’l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727 (2007). In this regard, the Supreme Court further noted that “rejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *Id.*, at 1396. Second, there must be a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim features. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

As explained above, the Murakami reference does not disclose or even suggest all of the features of claim 11, as presented. Claim 20 depends from claim 11, as presented, and is therefore allowable for essentially the same reasons provided above, since the Endo reference does not cure -- and is not asserted to cure -- the critical deficiencies of the Murakami reference.

Withdrawal of the rejection is therefore respectfully requested.

New claims 21 to 26 do not add any new matter and are supported by the present application, including the specification. Claims 21 to 26 depend from claim 11, as presented, and are therefore allowable for the same reasons as claim 11, as presented.

In sum, claims 11, 12, 14, 15 and 18 to 26 are allowable.

Conclusion

It is therefore respectfully submitted that all of the presently pending claims are allowable. It is therefore respectfully requested that the rejections and objections be withdrawn, since all issues raised have been addressed and obviated. An early and favorable action on the merits is therefore respectfully requested.

Respectfully submitted,

Dated: October 17, 2008

By: /Gerard A. Messina/
Gerard A. Messina
Reg. No. 35,952

KENYON & KENYON LLP
One Broadway
New York, New York 10004
(212) 425-7200

CUSTOMER NO. 26646